

REMARKS

Claims 5, 6, 11, 12, 17 and 18 were previously withdrawn in response to a restriction requirement, and therefore claims 1 to 4, 7 to 10, 13 to 16 and 19 to 24 are now pending and being considered in this application.

It is respectfully submitted that all of the presently pending and considered claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for acknowledging acceptance of the Drawings, and for acknowledging that certified copies of the of the priority documents have been received.

With respect to paragraph four (4) of the Final Office Action, claims 1, 3, 7, 9, 13, 15, 19, 21 and 23 were rejected under 35 U.S.C. § 102(e) as anticipated by Cox al., U.S. Patent No. 5,915,027.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine must fail absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, each of the independent claims has been rewritten to better clarify the claimed subject matter.

As to claim 1, as presented, the Final Office Action cited the text at col.4, lines 45 to 65, for the claim feature of a “complexity of said block data” in the Response to Arguments.

More particularly, the Final Office Action apparently asserts that output from spectral transformer in Cox corresponds to the “complexity of data”, as provided for in the context of the claimed subject matter. However, as is clear from the cited paragraph of Cox, the transformer is simply for converting data into frequency domain -- namely, for obtaining a frequency coefficient. The Cox reference does not identically disclose (nor even suggest) the claim features relating to the complexity of block data, including the added feature of claim 1, which further provides that the larger said complexity is, the larger said amount of transformation is. Accordingly, claim 1, as presented, is allowable, as is its dependent claim 2.

As to claim 3, as presented, the cited portion (column 6/lines 3-49) in Cox does not identically disclose (nor suggest) the feature “obtaining an amount of transformation of said frequency coefficient from said digital watermark data by using a quantization width corresponding to said frequency coefficient, said quantization width being obtained beforehand according to a manipulation method of said digital data contents, *wherein said amount of transformation is obtained such that the larger a change amount of said digital data contents due to processing by said manipulation method is, the larger said amount of transformation is*.” Accordingly, claim 3, as presented, is allowable, as is its dependent claim 2.

Accordingly, claims 1 and 3 are allowable, as are their respective dependent claims 2 and 4, since the foregoing features are nowhere identically disclosed (nor suggested) by the Cox reference.

Claims 7, 13 and 19, as presented, also now include features like those of claim 1, as presented, and are therefore allowable for essentially the same reasons as claim 1, as are their respective dependent claims 8, 14 and 20.

Claims 9, 15, 21 and 23, as presented, also now include features like those of claim 3, as presented, and are therefore allowable for essentially the same reasons as claim 3, as are their respective dependent claims 10, 16, 22, and 24.

With respect to paragraph six (6) of the Final Office Action, claims 2, 4, 8, 10, 14, 16, 20, 22 and 24 were rejected under 35 U.S.C. § 103(a) as obvious over Cox et al. in view of Ho et al., U.S. patent No. 6,983,057.

As explained above, claims 1 and 3 are allowable, as are their respective dependent claims 2 and 4, since the foregoing features are nowhere disclosed nor suggested by the Cox reference.

Also, claims 7, 13 and 19, as presented, also now include features like those of claim 1, as presented, and are therefore allowable for essentially the same reasons as claim 1, as presented, as are their respective dependent claims 8, 14 and 20.

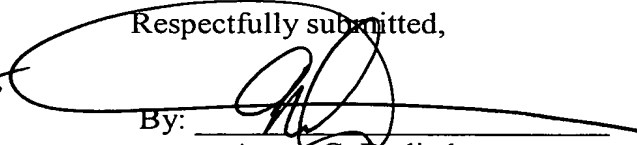
Also, claims 9, 15, 21 and 23, as presented, also now include features like those of claim 3, as presented, and are therefore allowable for essentially the same reasons as claim 3, as presented, as are their respective dependent claims 10, 16, 22, and 24.

In short, claims 2, 4, 8, 10, 14, 16, 20, 22 and 24 respectively depend from their respective base claims, as presented, and are therefore allowable for essentially the same reasons as their respective base claims, as explained above, since the secondary reference does not cure – and is not asserted to cure – the critical deficiencies of the primary Cox reference.

Accordingly, pending and considered claims 1 to 4, 7 to 10, 13 to 16 and 19 to 24 are allowable.

Conclusion

It is therefore respectfully submitted that pending and considered claims 1 to 4, 7 to 10, 13 to 16 and 19 to 24 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,
Dated: 4/9/2008 By: 
Aaron C. Deditch
Reg. No. 33,865

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646